

### **REMARKS**

Claims 1-24 are pending. Claims 14-24 have been withdrawn from consideration by the Examiner for reciting non-elected subject matter. By this Amendment, Claims 1 and 14 are amended. As support for the amendments is provided in the originally filed application, for example, see Figure 3, Applicant respectfully submits that no new matter is presented herein.

### **Affirmation of Election**

On January 6, 2006, Applicant's representative provisionally elected to pursue prosecution of Claims 1-13 in a telephone conversation with the Examiner. Applicant herein affirms the election as required by the Office Action.

### **Rejoinder Requested**

Applicant respectfully notes Claims 1 and 14 recite a common patentable feature and respectfully request the Examiner reconsider rejoining non-elected Claims 14-24 into the instant application.

### **Allowable Subject Matter**

Applicant appreciates and acknowledges the indication by the Examiner that Claim 5, although objected to for being dependent upon a rejected base claim, would be allowable if amended to incorporate all of the features of the base claim and any intervening claims.

### **Specification**

The Title is objected to for not being descriptive of the claimed invention. Applicant has amended the Title herein as suggested by the Examiner. Withdrawal of the objection is respectfully requested.

### **Claims 1-13 Recite Patentable Subject Matter**

Claims 1, 3, 4, 6-9, 11 and 13 were rejected under 35 U.S.C. § 102(a) as being anticipated by Applicant Admitted Prior Art (hereinafter "AAPA"). Claims 1-4, 6-10 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,286,236 to Miyawaki. Claims 11 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyawaki in view of the AAPA. Applicant respectfully traverses all three rejections for the following reasons.

#### **Claim 1**

Claim 1 recites a method of fabricating electronic parts, includes, among other steps, the recited step of providing dummy cavities so that the dummy cavities are located further out than the array of the regular cavities and surround the array of the regular cavities, wherein there are no electronic elements mounted in the dummy cavities. For example, as shown in the exemplary embodiment illustrated in Figure 3, the dummy cavities are arranged so as to be located further out than the array of regular cavities and are also provided without any electronic components or elements mounted therein.

#### **AAPA**

Applicant respectfully submits the AAPA fails to disclose or suggest the dummy cavities recited in Claim 1. Applicant notes the Office Action asserts reference number 111 identifies dummy cavities when in fact reference number 111 identified sound acoustic wave (SAW) devices and not dummy cavities. Put simply, the AAPA fails to disclose or suggest dummy cavities so that the dummy cavities are located further out than the array of the regular cavities and surround the array of the regular cavities,

wherein there are no electronic elements mounted in the dummy cavities. Therefore, Applicant respectfully submits the AAPA does not disclose or suggest each and every feature of Claim 1.

To qualify as prior art under 35 U.S.C. §102, a reference must teach, i.e., identically describe, each and every feature of a rejected claim. For the reasons discussed above, the AAPA does not disclose or suggest each and every feature recited by Claim 1. Thus, the AAPA does not anticipate or render obvious the invention recited by Claim 1. Hence, Applicant submits Claim 1 should be deemed allowable over the AAPA.

Claims 2-13 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable over the AAPA for at least the same reasons Claim 1 is allowable as well as for the additional subject matter recited therein.

#### Miyawaki

Miyawaki discloses the use of a cap member 2 and a sheet-like adhesive 3. In contrast, the claimed invention does not use any member like the cap member 2.

Miyawaki teaches multiple penetrating holes 5 provided at the corners surrounding the respective cavities 4. Thus, individual devices obtained by dividing the base substrate 1 have a part of the penetrating holes 5 therein. In contrast, the claimed invention does not have such features as those taught by Miyawaki.

Moreover, Applicant notes Claim 1 recites dummy cavities located further out than the array of the regular cavities and which surround the array of the regular cavities, wherein there are no electronic elements mounted in the dummy cavities. This is quite different from Miyawaki's penetrating holes 5, which include a metallized layer

that is routed therethrough for electrically connecting a conductive pattern laid on the front surface of the first substrate 1A to the exposed external terminal 11, which is laid on the reverse side of the first substrate 1A (see column 3, lines 49-53). Thus, the individual devices after dicing, do not have any portion of the dummy holes. Therefore, Applicant respectfully submits that Miyawaki does not disclose or suggest each and every feature of Claim 1.

To qualify as prior art under 35 U.S.C. §102, a reference must teach, i.e., identically describe, each and every feature of a rejected claim. For the reasons discussed above, Miyawaki does not disclose or suggest each and every feature recited by Claim 1. Thus, Miyawaki does not anticipate or render obvious the invention recited by Claim 1. Hence, Applicant submits Claim 1 should be deemed allowable over Miyawaki.

Claims 2-13 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable over Miyawaki for at least the same reasons Claim 1 is allowable as well as for the additional subject matter recited therein.

#### Claims 11 and 13

Claim 1 is discussed above.

The AAPA and Miyawaki are also discussed above with regards to Claim 1. Applicant notes that as stated above, the AAPA and Miyawaki, alone or in any combination, fails to teach or suggest each and every feature recited by Claim 1.

Claims 11 and 13 depend from Claim 1 and include all of the features recited therein. Therefore, the AAPA and Miyawaki cannot teach or suggest each and every feature recited by Claims 11 and 13.

To establish *prima facie* obviousness, each and every feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03. As the AAPA and Miyawaki fail to teach or suggest each and every feature recited by Claims 11 and 13, Applicant respectfully submits that Claims 11 and 13 are not rendered obvious in view of the combined teachings of the AAPa and Miyawaki and should be deemed allowable.

Applicant respectfully requests withdrawal of all three rejections.


### **Conclusion**

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding objection and rejections, rejoinder of Claims 14-24, allowance of Claims 1-24, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to **attorney docket number 025720-00023**.

Respectfully submitted,

  
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